REMARKS

1. Applicants have carefully reviewed the Office Action dated May 16, 2006. Reconsideration and favorable action is respectfully requested.

2. Claims 22-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hudetz et al.* in view of *Ogasawara* and *Simonoff et al.* This rejection is respectfully traversed with respect to the claims as currently presented.

3. Claim 22 is the independent claim and basically is a method claim that requires a number of steps. The first step is to provide an input device that has associated therewith a "unique input device ID" that is "permanently" associated with the input device and it is independent of the first location. The second step is to scan a product code with this input device. This product code is representative of the product in a commercial transaction. This scanning operation extracts information from the product code. Thereafter, there is a step of associating the unique value extracted from the product code with the input device ID and then transferring this over the network. There is a "predetermined association" of a second location on the network with the *combination* of the unique value and the unique input device ID. In response to this scanning step and the associating step, a connection is made to the second location, the second location being the one that has the predetermined association with the combination of the unique value and the unique device ID.

4. As noted in the specification, one of the purposes of this claimed combination of steps is to allow a manufacturer to distribute a device with a permanent ID, which permanent ID can then be used, in combination with a product code, to connect a user to a particular website. The example is that of a manufacturer that distributes the scanning device and then, based upon the fact that this manufacturer scanned the code, there can be a predetermined routing to a particular website based upon the scanner ID and the scanned code. If, for example, one cola manufacturer, for example, cola manufacturer A, distributed a scanning device and the scanner scanned a code associated with cola manufacturer B, then scanning cola manufacturer A could

provide a website that would actually provide a coupon based upon the item scanned from cola manufacturer B for the person that scanned the system in order to somehow promote sale of their product.

5. In order to properly reject a claim for obviousness, the PTO must first establish a *prima facie* case. Once the PTO has established such a *prima facie* case, the burden then shifts to the Applicant to provide sufficient evidence of the nonobviousness to successfully rebut such a *prima facie* case. What constitutes a *prima facie* case can, however, vary on a case-by-case basis.

6. With respect to obviousness, a claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *In re Kahn*, *441 F.3d, 977, 985* (Fed. Cir. 2006) (citing *Graham v. John Deere Co., 383 U.S.1, 13-14, 86 S.Ct. 684, 15L, Ed. 2d 545, 1962*.) Obviousness is a question of law, based upon underlying factual questions which are reviewed for clear error following a bench trial. These "underlying factual inquiries include: (1) The scope and content of the prior art; (2) The level of ordinary skill in the prior art; (3) The difference between the claimed invention and the prior art; and (4) Objective evidence of nonobviousness." *Alza Corporation v. Mylan Laboratories, Inc. and Mylan Pharmaceuticals, Inc., 464 F.3d 1286, 1288 (2006),* citing *In re Dembiczak, 175 F.3d 994, 998 (Fed. Cir. 1999).*

7. In *Khan* the Court noted that:

> "to reject claims in an Application under *§ 103*, an Examiner must show an unrebutted *prima facie* case of obviousness… on appeal to the board, an Applicant can overcome a rejection by showing sufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of a secondary indicia of nonobviousness." *(Kahn at 985)*

8. When combining references, it is well recognized that most inventions arise from a combination of old elements and each element may often be found in the prior art. *In re*

Rouffett, 149 F.3d 1350, 1357. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole." *Kahn* at 986, citing *Rouffett* at 1355, 1357. *Khan* further went on to state that:

> Rather, to establish a *prima facie* case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. Id. In practice, this requires that the Board "explain the reasons one of the ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." *Id. at 1357-59.* This entails consideration of both the "scope and content of the prior art" and "level of ordinary skill in the pertinent art" aspects of the Graham test. *(Kahn at 986)*

9. The primary test that has been put forth by the Federal Circuit is the motivation-suggestion-teaching test. *Kahn* set forth that, when there is no explanation provided by the Board to explain the motivation, or the suggestion or the teaching, that would have led a skilled artisan at the time of the invention to the claimed combination as a whole, then the court would infer that hindsight was utilized to conclude that the invention was obvious. *Kahn* relied upon the *Rouffett* case for this teaching at 1358. The "motivation-suggestion-teaching" requirement was set forth to protect against the entry of hindsight into the obviousness analysis, a problem which § 103 was meant to confront. Thus, there is a requirement, in order to establish a *prima facie* case, that there be some explanation as to motivation, suggestion or teaching of each of the references and how they can be combined.

10. Although the motivation-suggestion-teaching test has been set forth, there is still the "analogous-art" test that must first be applied, this being one test that was articulated by the Supreme Court as a part of the Graham analysis. See *Dann v. Johnston, 425 U.S. at 219, 226, 96 S. Ct. 1393, 47 l. ed. 2d 692 (1976).* "The analogous-art test requires that the Board show that a reference is either in the field of the Applicant's endeavor or is reasonably pertinent as to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection." (*Kahn* at 987). The following was further stated by *Kahn:*

> References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. Id. ("It is necessary to consider \the reality of the circumstances, in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." (quoting *In re Wood, 599 F.2d 1032, 1036 (C.C.P.A. 1979)*)). We have explained that this test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and that it is meant to defend against hindsight. See id.; *In re Clay, 996 F.2d 656, 659-60 (Fed. Cir. 1992)*. n3" *(Kahn at 987)*

As such, it can be seen that the first step of analyzing the combination that the Examiner has provided is to first look at the combination of references and determine if they satisfy the analogous-art test.

11. The primary reference that the Examiner has cited is the *Hudetz* reference. This reference has been discussed before, but Applicant will revisit the operation thereof. The primary purpose of *Hudetz* is to provide a means for a user to scan a product code on a manufactured item, such as a can of vegetables. The scanning operation results in transfer of the information in the scanned code to a database, which database then is operable to perform a look-up code. A matching operation is then made and the "matching records" are returned. In general, the transfer of the UPC code to the database is termed to be a query, which query is for the purpose of returning to the user an associated URL that is associated in the database for that particular scanned code. A query page is then displayed on the CRT at the local host using a forms capable browser. (Column 7, lines 43-51.) When the user sets a system up, the first step is to provide a "query page" in the browser software that provides access to the database. (Column 8, lines 21-24.) There is a distinction made in that a human could be the user that loads the program or it could be the machine running a process. Thereafter, this query page is transmitted to the local host computer in the form of a HTML document. The preferential way of inputting the information into the query page is to scan the UPC symbol. This way, the user can scan in multiple UPC codes and then transmit all of these to the database wherein the database will then retrieve all of the records that have matching UPC fields. The records are then

conveyed to the user in the form of an HTML document that is displayed for the user. (See Figure 6). These records are then displayed for the user and the user is provided the option of clicking on those particular records to go to a particular website.

12. In other alternate embodiments of the *Hudetz* reference, there is reference to "automatic jumping" to a desired location. This is an operation wherein the user must somehow set a flag to examine the returned HTML document in order to make a decision as to the returned records. This is because there is a possibility of returning multiple records for a query. This is an alternative to displaying the query results. However, there is no disclosure as to how this would be facilitated.

13. In general, the primary purpose of *Hudetz* is to provide users a convenient access to information located on computer networks such as the internet. (Column 1, line 17-19). As stated in the Summary of the Invention section, this invention provides a better way for consumers and others to access resources on remote computers. This is facilitated by the barcode or other indicia that is associated with a product or other article of commerce.

14. The question is whether the combination of *Hudetz* with *Ogasawara* and/or *Simonoff* all relate to analogous-art. As the Examiner has noted in the Office Actions *Ogasawara* is provided for the disclosure of a "permanently associated ID telephone number" with a device, specifically referring to column 10, lines 1-41 of *Ogasawara*. The *Simonoff et al.* disclosure is provided for the purpose of supporting the "unique ID" portion of the claim. The Examiner stating that *Simonoff*, at column 11, lines 13-16, discloses a unique ID which is commonly associated with a message (value) between different locations.

15. With respect to the *Ogasawara* reference, this is a reference that discloses an electronic shopping system. The purpose of the system is set forth in the abstract as it "facilitates purchase transactions via a wireless telephone." This wireless telephone is utilized for the purpose of scanning a barcode, in one embodiment, and sending this barcode along with information identifying the source of the transmission to a server. The purpose of this combination of information is to provide for two things. The first is to utilize the scanned code to retrieve

information and return it to the user, i.e., information about the scanned product. The second is to interface the transaction with the user profile for the purpose of updating user records, storing scan codes for items to be purchased and even storing scan codes for items that are not purchased but which may have been looked at. There is no association stored in any database between the scanned code sent in conjunction with the telephone number. This action in and of itself really does not require the telephone number or any information from the phone other than for the purpose of returning information associated with the transmitted scanned code back to the requesting location. This is no different than a computer on a network requesting information about a barcode for the purpose of completing a transaction in a Point of Sale (POS) system. In those systems, a computer must request information and the server or the such, in order to send the information back to the requesting node, must know the address of that node and return information to that node, noting that there is already an open connection, thus not requiring any telephone number for the return. For the purposes of this disclosure, the reason for receiving a telephone number of the user and utilizing that telephone number, is to allow verification of the user prior to returning information. In this particular disclosure in *Ogasawara*, the phone number specifically allows the user to complete a transaction utilizing their phone apart from and separate from returning information to the user regarding the transmitted scanned code. Thus, a user can scan a code, enter the code into the server such that a running list is kept under that user's name and then the user can utilize the phone to complete a transaction at a later time at a cash register by scanning in the code of the cash register. Thus, the scanned in codes, other than being returned and displayed to the user, are maintained in a database in association with that telephone number *after* transmission and not before. The reason to associate it with a customer is for the purpose of maintaining credit card information and the such to complete a transaction, in addition to the fact that the store wishes to keep track of the user. However, *Hudetz* is a system that scans for the purpose of returning information based upon looking up a URL. The *Ogasawara* reference discloses a device that is nothing more than a scanner that requests information regarding the scanned code totally separate from the telephone number.. *Ogasawara*, for this purpose, is no different than any POS terminal. The remaining portion of *Ogasawara*, that associated with utilizing the telephone number to complete a transaction, etc., is not related to *Hudetz*. However, this is a system that provides information in response to the

scanning of a code and sending of the information in that code to a server to return information about the code itself. However, the Examiner is utilizing this for the purpose of the element "the input device having associated therewith a unique input device ID that is 'permanently' associated with the input device and independent of the first location." The question, more importantly, becomes whether providing a telephone number that is arguably fixed with respect to the phone, would be analogous-art to permanently affixing an ID in a scanner. First, a scanner is different than a telephone. Second, when you permanently affix an ID in a scanner, this is permanently fixed in the scanner such that neither the user nor anyone else can change it. It is shipped with the unit and not alterable. Compare that with a telephone, especially a wireless telephone. The wireless telephone really has nothing more associated with it than a fixed ID number or serial number in the phone. In accordance with CDMA technology, a phone number is something that a telephone network associates with that particular phone. This particular phone number is associated with the customer, as the customer virtually owns that telephone number, depending upon the type of contract that they have. In some situations, the phone company owns the telephone number and not the customer. However, in any event, this phone number is not permanently associated with the telephone; rather, it is at best associated with the customer and it can, at any time, be associated with another phone. Therefore, Applicants believe that the *Ogasawara* reference is not an analogous reference with respect to this element. Applicant does not believe that one skilled in the art would look toward a telephone unit, especially a wireless telephone unit, for the purpose of providing a scanner with a "permanently" affixed unique ID.

16. The Examiner has provided the *Simonoff* reference for the purpose of supporting the rejection of the claim for the element "the unique ID" that is associated with the message packet. The Examiner is referring to the disclosure in *Simonoff* at column 11, lines 13-68. The *Simonoff* reference is a reference that provides a computer system and nodes that are referred to as "universal client devices." The manner in which this operates is to provide this universal client device on the network and then allow the server to interface with that universal client device. The particular operation of assigning a particular ID to a particular universal client device is set forth in column 11, beginning at line 12 as follows:

> After the Universal Client device on the client host 300 establishes the Transmission Control Protocol/Internet Protocol (TCP/IP) socket connection, the host server 100 immediately responds, in an exemplary case, to the Universal Client device with the characters "(Client:you_are_id_number)," where id_number is a unique 8-digit integer, during step 4. It will be appreciated that a computer generated server host socket hashcode value is generally recommended for id_number, since it is guaranteed to be unique and since it identifies the logical socket connection between the server host 100 and the client host 300 running the Universal Client device. It should be mentioned that the server host 100 advantageously can selectively send GUI-Script to multiple client hosts 300a-300r, as shown in FIG. 2 by filtering the ID_number.

It can be seen from this that there is no permanent affixing of the ID to a particular device but, rather, just an assigning of an ID for the purpose of recognizing the system on a network, during a communication session, i.e., this is a source or distribution address. This is to be compared with such systems as Ethernet cards, which have an ID permanently associated therewith at the time of shipping. Thus, would a software ID that is provided to a system that then uniquely identifies a node on a network but which is not associated with it, be analogous-art when a person in the scanner art is seeking to permanently affix a unique ID to a scanner? Applicants believe that such is not the case, as one would not look to this type of system to provide any unique ID that is utilized for the purpose of matching as opposed to identifying a source address on a network. Therefore, Applicants believe the *Simonoff* reference is not analogous art.

17. Even though Applicants believe that these references are not necessarily analogous, the next step for determining obviousness is to analyze the motivation-suggestion-teaching test which:

> . . . picks up where the analogous art test leaves off and informs the Graham analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, [**23] or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law, see *§ 103(a); Graham, 383 U.S. at 35;*

Dann, 425 U.S. at 227-29, and helps ensure predictable patentability determinations. (*Khan at 987).*

18. Despite that all elements of the claim may have been disclosed in various prior art references, it has long been a rule that the claimed invention, as a whole, (*In re Hiraro, 535 F.2d, 67, (C.C.P.A. 1966)* can not be said to have been obvious as there must be some reason or motivation given in the prior art why someone would have been prompted to combine the teachings of the references. (*In re Regel, 526 F.2d, 1399 (C.C.P.A. 1975); In re Bond, 910 F.2d, 831, (Fed. Cir. 1990)).* The prior art itself may suggest desirability of a combination, or the motivation may come from other sources (for example, economic factors). (See e.g. *In re Clinton, 527 F.2d 1226 (C.C.P.A. 1976); Cable Elec. Prods., Inc. v. Genmart, Inc., 77 F.2d 1015 (Fed. Cir. 1985)).* Thus, the motivation to combine the relevant art or teachings does not have to be found explicitly in the prior art but, rather, can be implicit thereto. "However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn at 988 referring to Lee, 277, F.3d at 1343-46 and Rouffett, 149 F.3d at 1355-59.)* The purpose of such requirement is to ensure "due process and non-arbitrary decision making", as it is in § 103. (*Kahn at 988).*

19. *Kahn* articulated the considerations for motivation when analyzing obviousness. The Court in *Kahn* stated that "the problem examined is not the specific problem solved by the invention, but the general problem that confronted the inventor before the invention was made." (*Kahn at 988 referring to Cross Medical Products, Inc. v. Metronics Sofamore Danek, Inc., 424 F.3d 1293, 1323 (Fed. Cir. 2005)).* In the reference in *Cross*, the quote that was cited by the Court in *Kahn* (*Cross at 1323)* was that "one of ordinary skill in the art need not see the identical problem addressed in the prior art reference to be motivated to apply its teachings." As to motivation, the Courts upheld that the evidence of motivation to combine the prior art references "may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved." *Medichem I.V., 437 F.3d at 1165, quoting Brown and Williamson Tobacco Corp. v. Phillip Morris, Inc., 229 F.3d, 1120, 1125 (Fed. Cir. 2000.) Kahn* summarized the motivation-suggestion-teaching test as follows:

> Therefore, the "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. See *Cross Med. Prods., 424 F.3d at 1321-24*. From this it may be determined whether [**26] the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art--i.e., the understandings and knowledge of persons having ordinary skill in the art at the time of the invention--support the legal conclusion of obviousness. See *Princeton Biochemicals, 411 F.3d at 1338* (pointing to evidence supplying detailed analysis of the prior art and the reasons one of ordinary skill would have possessed the knowledge and motivation to combine). *Kahn at 988.*

Thus, in order to prove obviousness with the combination of *Hudetz*, *Ogasawara* and *Simonoff*, the Examiner must provide an explanation as to whether the overall disclosures of these three references, the teachings therein and the suggestions associated therewith, in addition to the level of skill in the art, support the Examiner's conclusion of obviousness as to the invention as a whole.

20. First, the *Hudetz* reference is analyzed with respect to the claims to determine the shortcomings thereof in anticipating and/or obviating the claim. Independent Claim 22, as currently presented, is directed, in the preamble, to a method for interconnecting one location on a global communication network i.e., the internet, with the second location thereon. The first step is to provide an input device coupled to the first location on the global communication network. *Hudetz* does provide for a scanner to provide such. The next portion of the claim requires that the input device have associated therewith a unique input device ID that is *permanently associated with the input device* and independent of the first location. Certainly, the input device of *Hudetz* has no such unique input device ID nor is there have any suggestion or teaching that such would be useful for the intended purpose. As noted herein above, the purpose of *Hudetz* is to provide "a system and method for using identification codes found on ordinary articles of commerce to access remote computers on a network." (*Hudetz*, Abstract). In the background of the invention, *Hudetz* set forth the problems that were being addressed. One problem noted was that manual entering of published computer addresses, either URLs or

otherwise, were difficult to enter because they have to be tediously entered into the computers. (See column 2, lines 37-40). One example of this was the University of Texas address. A second problem that was noted was the trouble of even finding URLs or network addresses for desired sites such as web pages, leading to website sponsors publishing their website URLs in print advertising and on packaging. Again, the URLs are long and cumbersome to remember. A co-pending application of *Hudetz* solved this problem by allowing people to access published locations without having to enter the published address. When the address is published, the barcode has that address encoded therein such that a bar code reader can be utilized to load this desired numeric address into the browser. This was noted as providing a problem in that the network address can not contain upwards of 20-30 characters, thus requiring very long barcode symbols. Further, placement of the URLs on printed material required the manufacturer to redesign their products. Third, if the network address is changed, then the package needs to be redesigned.

21. The solution to all of these problems was arrived at for the purpose of offering a better way for consumers and others to access resources on remote computers, particularly websites. This was set out in the Summary of the Invention section. This solution is to utilize an existing product code, which product code has a predetermined purpose, and then "repurposing" this barcode by providing a remote site on which the URL is disposed in association with the barcode. This requires merely the reading of the barcode and transferring of this barcode to a computer, either remote or local, for the purpose of determining the associative link. This requires the opening of a browser or a query page, entry of the various barcodes, sending of the query and then the return of an HTML document with all of the potential responses. Thereafter, the user can select a particular location from this list. Therefore, in summary, *Hudetz* provides a system that repurposes a particular barcode for the purpose of returning information to a user in the form of URLs. There is no suggestion or need for any type of ID as there is no suggestion in *Hudetz* for in any way "filtering" the return addresses by any other information other than the scan code. All that is disclosed in *Hudetz* is the transmission of the encoded information within a barcode for the purpose of doing a "match" in the database and then returning a URL in an HTML document for presentation to the user. Thus, there is no suggestion or teaching in *Hudetz*

for the need of providing any type of ID in association with the scanning device nor a device ID that is permanently associated with the scanning device and further, provide this in a way that it is independent of the location at which the scanner is disposed. Such ID would not further the purpose of *Hudetz* or aid in solving the stated problems therein.

22. The second step of Claim 22 is that associated of scanning a product code disposed on a product with the input device. *Hudetz* does provide the operation of scanning this product code and the product code is one that is representative of the product in commercial transactions. The step of scanning is operable to extract the information contained in the product code and this thus provides a unique value, and *Hudetz* discloses such.

23. The third step of the claim is associating the unique input device ID in a message packet. The only disclosure in *Hudetz* is to provide the unique value associated with the barcode. There is no teaching or suggestion in *Hudetz* that would provide for a unique input device ID. Again, the purpose of *Hudetz* is to offer a better way for consumers and others to access resources on remote computers, particularly websites. The unique ID does not further this purpose. The unique ID in the claimed invention is a filtering device that allows the creator of a database to further filter the information that is sent to the user, i.e., the controller of the database that generates the information now has an additional piece of information, possibly even unknown to the user, that it can utilize in order to provide a response. The device ID has no relationship with a product and it does not allow a user to better access resources on remote computers or even better access different remote websites. Thus, there is nothing in *Hudetz* that would motivate one to search further and look for a solution of somehow providing a unique input device ID in the scanner for the purpose of later associating that with the barcode value. Again, this third step of Claim 22 requires that there be a second location on the website that has a predetermined "association with a combination of the unique value and the unique input device ID" for the purpose of associating the second location with both of these values. There is no reason to do such in order to achieve the purpose of *Hudetz* and, therefore, there is no reason for one, faced with the problems to be solved by *Hudetz*, to seek a solution utilizing the "additional" device ID to permanently place in the scanner. In fact, there is no discussion in *Hudetz* of what type of

scanner to be utilized for the particular operation. In *Hudetz*, beginning at column 8, line 34, it is stated:

> Because the UPC product identification number is printed in both machine and human-readable format (See Fig. 3), this may be done by manual entry using keyboard, voice recognition system or other input device. More preferably, however, entry is accomplished by scanning UPC symbol 46 affixed to article 48. Input device 44 reads UPC symbol 46, and generates an ASCII character string which is read by CPU 30 via I/O port 38. if the UPC number is scanned, then all 10 digits will generally be entered.

It can be seen that manual entry is one type of entry, as well as voice recognition. There is no way to permanently affix an ID to this type of input. As such, *Hudetz* acknowledges that such is not required nor contemplated. In fact, in Applicants present invention, if a different scanner with a different unique ID were utilized, this would result in different information being returned to the user. From the disclosure of *Hudetz*, the barcode reader has no significance to the overall operation other than as an input device. In the claimed invention, the input device has an important purpose and that is to provide a way for a manufacturer to ship to an individual a barcode reader with a "permanently affixed unique ID" for the purpose of controlling the information that is sent to the user. The user has no knowledge of this particular operation and, therefore, it does not facilitate the purpose of *Hudetz*, i.e., to allow a user easier access to websites by providing a repurposing engine for a particular barcode. Thus, the Examiner must show that there is a motivation to solve the problem solved by Applicants' present claims and also provide a reference that, at the time of the invention, somehow suggested that there was a problem that needed to be solved and provide teaching as to how to solve that problem by incorporating a unique input device ID into a scanner that could be utilized in the *Hudetz*-system for the purpose of allowing a matching operation to be performed at a database wherein that database had a unique association between the input device ID and a barcode symbol.

24. The Examiner has relied upon the *Ogasawara* reference to, as the Examiner has set forth, provide a teaching of an input device having an input device ID *permanently* associated with the input device and independent of the first location. The Examiner indicates that this is supported

by the fact that *Ogasawara* discloses a permanently associated ID telephone number (referring to the disclosure at column 10, lines 1-41). The disclosure of column 10, lines 1-41 is set forth as follows:

> use of the cellular network 17 are avoided. Those skilled in the art will appreciate various other means of providing in-house radio communication between the wireless telephone 18 and the store server 10 are likewise suitable.
>
> In use, a purchaser merely dials the telephone number of the store server 10 or remote server 26 with the wireless telephone 18. Upon connection of the wireless telephone 18 to the store server 10 or the remote server 26, the purchase transaction program is downloaded from the store server 10 or the remote server 26 into the wireless telephone 18 under the direction of a program loader 32 (FIG. 2).
>
> More particularly, the telephone interface of the store server 10 or remote server 26 facilitates receipt of the telephone call from the customer and downloading of the appropriate purchase transaction program to the wireless telephone 18. The server personal shopping application facilitates sending and receiving of information between the customer's wireless telephone 18 and the store server 10 or remote server 26. When the store server 10 or remote server 26 is called by the customer's wireless telephone 18, then the telephone interface obtains the customer's phone number and then searches the customer information database in the store server 10 or remote server 26 in order to obtain the following information: customer's telephone number, download program ID, customer ID, and customer name. This information is preferably stored in the store server 10 or remote server 26 when the customer enrolls in the personal shopping application. In this manner, the customer's telephone number provides a degree of validation, and thus serves to indicate that the customer is authorized to make purchases.
>
> Based upon the download program ID, the appropriate download program is downloaded from the store server 10 or remote server 26 to the wireless telephone 18. The particular purchase transaction program (which has a unique ID) which is transmitted from the store server 10 or remote server 26 to the wireless telephone 18 is selected so as to be consistent with the

purchaser's profile, e.g., telephone type, as well as the purchaser's personal preferences, such as language and particular interests.

25. This portion of the disclosure sets forth that the purpose of the telephone number is that, when the store server is called, the telephone interface will obtain the customer's phone number from that call and then it searches the customer information database "in order to obtain the following information: customer's telephone number, download program ID, customer ID, and customer name." (Column 10, lines 23-25). The purpose is further stated that "in this manner, the customer's telephone number provides a degree of validation, and thus serves to indicate that the customer is authorized to make the purchase." (Column 10, lines 27-31). However, the response of the server in returning information to the user about the scanned code sent in conjunction with the telephone number is not at that time involved with a purchase.

26. The Examiner has indicated that motivation is provided because "it would be obvious to modify *Hudetz et al.* to include such an ID because the motivation would be to allow the input device 120 to be free of a base station." (May 18, 2006 Office Action, page 2). The purpose of the scanner and the use of the unique ID has nothing to do with being free of any type of base station or location. The purpose is to provide a scanner that is associated more with a retailer and not with the location itself, i.e., it is not location specific. The unique ID itself is utilized for the purpose of filtering and determining what the information is that is returned to the user. Therefore, *Ogasawara* would have to provide some type of ID that was both permanently associated with the particular input device and which had the purpose of being stored in a database in order to provide one motivation to combine with *Hudetz*. There is no such purpose disclosed in *Ogasawara*. The telephone number is merely for the purpose of validating that the user is in the database, and the purpose for this is to allow a user to complete a later transaction after multiple desired items are flagged for purchase and to possibly complete the purchase with a pre-stored credit card. Further, the user telephone number is allowed to define a certain portion of the database in which information can be stored as to that user's purchase habits. Even though a barcode may be sent in association with or shortly after a particular telephone number is sent, this barcode merely indicates that information is requested and there is no use of the customer's telephone number to in any way affect what type of information is returned, i.e., all that is

needed is the scanned code. Additionally, the claim requires that this ID be "permanently" associated with the input device. This is a telephone number. The telephone number is unique to a particular customer at that time. The customer contracts with a telephone network or with a provider to either own the telephone number or to utilize the telephone number (sometimes certain providers only provide the telephone number as long as the bill is paid, after which the telephone number is recycled). Further, the telephone device is a wireless telephone. Wireless telephones do not have any telephone number permanently affixed thereto. They have a serial number. This serial number or ID code stored therein must be sent to a central location to look up the telephone number of the user for the purpose of providing the telephone number in a caller ID function. Thus, the phone itself does not have a telephone number uniquely or permanently fixed thereto - it can be associated with a different telephone at any time by the user. The user can dispose of the telephone and obtain another telephone. Therefore, there is disclosed no way to provide to a user an input device that has a ID permanently affixed thereto. Thus, there is no teaching or suggestion in *Ogasawara* that there is a permanently affixed ID associated with the telephone, that this permanently affixed ID would be useful to facilitate returning "information" to a user from a barcode other than the information that is always associated with that barcode. Thus, *Ogasawara* does not provide a system that would in any way teach a reason for utilizing a permanently affixed ID in an input device in the *Hudetz* reference.

27. The Examiner had made some comments with respect to this portion of Applicants arguments, which arguments have been presented before. The important portion of those comments are set forth on page 3 and page 4 of the current Office Action as follows:

> Applicant argues that nowhere in the art relied on by the Examiner is there a disclosure of the input device permanently affixed thereto . . . provided with a unique identifier. However, *Ogasawara* discloses, in col. 10 lines 43-46, that "each message coming from a wireless telephone 18 is associated with the customer's telephone number, customer ID or some other unique identifier". Applicant attempts to dilute this statement by stating instead that the wireless phone number "is associated with some type of customer phone number . . ." In *Ogasawara*, col. 10 line 21 it is stated that the customer's phone number which must be that which is associated with the phone referred to in the immediately preceding part of the

> sentence is used. Thus regardless of what the phone number is being used for by the system in *Ogasawara*, the phone number still answers the limitation of a unique ID tied to the device 18. The allegation that *Ogasawara* fails to associate the input device and the scanned item is irrelevant because the unique ID tied to the phone 18, which phone is independent of any location, is all that the examiner is relying on for in the *Ogasawara* reference in reference to claim 22. The motivation for combining *Ogasawara* and *Hudetz et al.* is set forth in the office action and is considered proper.

28. Applicant believes that this is clearly incorrect. The Examiner is basically stating that Applicant has made an attempt to dilute the Examiner's statement that *Ogasawara* disclosed that "each message coming from a wireless telephone 18 is associated with the customer's telephone number, customer ID or some other unique identifier" by stating instead that the wireless phone number "is associated with some type of customer phone number . . ." By focusing merely on the fact that there is a limitation of a unique ID tied to the device, the Examiner has done nothing more than identify a particular element in the prior art. *Kahn* stated that "however, a mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole." (*Kahn at 986)* Rather than merely concentrate on this element, the Examiner is required to articulate the basis on which the Examiner concludes that it would have been obvious to make the claimed invention, i.e., one of the reasons the Examiner is required to explain the reasons why one of ordinary skill in the art would have been motivated to select the references and to combine them in order to render the claimed invention obvious. There is no such teaching from the mere fact that the Examiner indicates a unique ID exists. Thus, Applicants believe that the Examiner has not met a *prima facie* case by stating that "regardless of what the phone number is being used for by the system in *Ogasawara*, the phone number still answers the limitation of a unique ID tied to the device 18." Further, the Examiner's statement that the fact that *Ogasawara* fails to associate the input device in the scanned item is irrelevant due primarily to the fact that the unique ID is tied to the phone 18 is incorrect, as this is certainly relevant to support an obviousness rejection. All the Examiner is relying on is that particular aspect and that is insufficient to show there is any motivation, suggestion or teaching that would lead one skilled in the art at the time of the invention to

combine the teachings of *Ogasawara* with *Hudetz* to allow one with the teaching of *Hudetz* in front of them to incorporate a scanner with a unique ID therein.

29. Applicants therefore believe that the Examiner has failed to show a *prima facie* case for the combination of *Ogasawara* and *Hudetz* that would lead one skilled in the art to utilize a scanner or an input device that has a unique ID permanently affixed thereto that is independent of any location.

30. The Examiner has further stated that *Hudetz* fails to disclose the unique ID as being associated with the message packet. The Examiner is relying upon the *Simonoff et al.* reference for such disclosure, citing the disclosure at column 11, lines 13-68 therein. That disclosure is set forth as follows:

> After the Universal Client device on the client host 300 establishes the Transmission Control Protocol/Internet Protocol (TCP/IP) socket connection, the host server 100 immediately responds, in an exemplary case, to the Universal Client device with the characters "(Client:you.sub.-- are id.sub.-- number)," where id.sub.-- number is a unique 8-digit integer, during step 4. It will be appreciated that a computer-generated server host socket hashcode value is generally recommended for id.sub.-- number, since it is guaranteed to be unique and since it identifies the logical socket connection between the server host 100 and the client host 300 running the Universal Client device. It should be mentioned that the server host 100 advantageously can selectively send GUIScript to multiple client hosts 300a-300r, as shown in FIG. 2, by filtering the id.sub.-- number.
>
> It should be mentioned at this point that any number of the multiple client hosts 300a-300r can be interactively connected to one another either by LAN 400 alone of through server 100 via LAN 400. Thus, client hosts 300a and 300b can be directly connected to one another so that the users can communicate with one another. FIGS. 7 and 8, which are discussed in greater detail below, illustrate an exemplary chat room which can be established between two or more users. It should also be mentioned that a single client host 300a advantageously can be connected to, for example, multiple application hosts 200a-200m so that the GUI displayed using the Universal Client device includes data

generated by several different application hosts 200a-200m. Of course, when referring to combat system applications, several client hosts 300a-300r preferably display the data generated by the application hosts 200a-200m, although each of the client hosts 300a-300r may display received information filtered through a unique GUI.

It will be appreciated that the purpose of the "Client:you.sub.-- are" message is to provide the Universal Client device with a unique identifier such that the server host 100 can distinguish which of the client hosts 300a-300r is sending GUIScript transmissions and positively identify which one of the client hosts 300a-300r will receive a GUIScript message from server host 100 via LAN 400. From this point on, any data sent from the Universal Client device will be appended with the client id.sub.-- number. Once the Universal Client device has the client id.sub.-- number, the next communication may be initiated by either the Universal Client device on the client host 100 or the server host 300. Each communication advantageously can be in the form of GUIScript, although the present invention is not limited Universal Client device which are responsive to GUIScript messages. It should be mentioned that the Universal Client device advantageously can respond to other stimuli such as an ASCII character string and datagram.

The Universal Client device beneficially can be made interactive to a character string by employing, for example, a so-called "wait-for" command which causes the Universal Client device to respond in a predetermined way when a character string having a specified format is received. Thus,

31. This portion of the disclosure sets forth that the universal client device be disposed on the network and be placed in communication with the host server. The host server then assigns an ID number to the universal client device. The purpose of this is to be able to distinguish different universal client devices on a network. As noted herein above, this is no different than providing an Ethernet card which has a fixed ID disposed therein. However, this particular ID number does not, in Applicants' opinion, correspond to the unique ID that is disposed in permanent association with the input device. Certainly, when communicating between a universal client device and a server, one would utilize in a query to the server the ID associated with the transmitting device for the purpose of providing a source address. This is typical of any

type of communication over a network. There would be an origination address, some type of information and a data field associated therewith and a destination address. This is fairly standard protocol. However, associating the unique ID in a message packet, in accordance with the claim, is done such that it is in association with the scan code. There is nothing in *Simonoff* that would lead one skilled in the art to utilize the teaching of *Simonoff* to incorporate such a unique ID in the message packet. This unique ID is the ID of the scanning device and it is not the address of the destination device for the purpose of matching to connect to a location having an association with the combination of the scan code and the ID. As with Ethernet cards, the unique serial number on that Ethernet card is disposed within a network look-up table such that there is a recognition of what the address is, and this is an address and not an ID used for recognizing a source node. Thereafter, all that is necessary is to place the communication on the network device that can be recognized by a particular node. There is no purpose of the ID in the claim such that the unique ID would be utilized for such a purpose. Therefore, there is no reason or motivation for anyone faced with the problems set forth in *Hudetz* to utilize this unique ID for the purpose of providing a match in a database, i.e., the only purpose for the ID in *Simonoff* is to provide a particular node on a network for the purpose of generating a communication path. *Hudetz*, with TCP/IP communication, already has such a source address, so why is an additional one needed? There is no such source address use of the ID in the claim and, therefore, Applicants believe that there is no motivation, suggestion or teaching in *Simonoff* that would lead one skilled in the art at the time the invention was made to utilize this particular source address ID for the purpose of a matching operation utilizing a totally separate ID. These IDs are for diametrically opposite purposes and, therefore, Applicants believe that the combination of *Simonoff* and *Hudetz* would be improper.

32. The Examiner has provided no reference that would illustrate that there is any second location on a network that has a predetermined association with a combination of a unique value and a unique input device ID, wherein the association between the unique value and the unique input device ID associates the second location with both the unique device ID and unique value. It is this association that allows the connection of the first location to the second location. All that the Examiner has done is provide *Ogasawara* for the purpose of providing a unique input

device ID in association with the input device and *Simonoff* for providing the combination of an ID and a message. There is nothing in the disclosure of *Hudetz*, *Ogasawara* and *Simonoff*, taken singularly or in combination, that in any way shows a second location that has an association with the combination of those two values. If there was no such association, there is no reason to transmit the combination of the input device ID and the scan code in the message packet. As such, even if the combination of *Ogasawara*, *Hudetz* and *Simonoff* were proper, which Applicants believe they are not, that combination fails to disclose the whole invention as set forth in the claim.

33. In view of the above, Applicants respectfully request withdrawal of the 35 U.S.C. § 103 rejection with respect to claims 22-27.

34. Applicants have now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicants respectfully request full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/PHLY-24,913 of HOWISON & ARNOTT, L.L.P.

Respectfully submitted,
HOWISON & ARNOTT, L.L.P.
Attorneys for Applicant

/Gregory M. Howison Reg. #30,646/
Gregory M. Howison
Registration No. 30,646

GMH:dd

P.O. Box 741715
Dallas, Texas 75374-1715
Tel: 972-479-0462
Fax: 972-479-0464
November 20, 2006